

REMARKS

Favorable consideration and allowance of the subject application are respectfully solicited.

Status of the Claims

Claims 9-19 are pending in this application, with Claims 9, 14, 17 and 18 being independent. Claims 9-13 have been withdrawn from consideration. Claims 14-19 are newly presented. Support for the thickness of the barrier layer in Claim 16 may be found in the specification at least at page 12, line 27 to page 13, line 1. It is submitted that no new matter has been added.

Restriction Requirement

The Examiner has imposed a restriction requirement between Group (I) Claims 1-8, directed to recording medium, and Group (II) Claims 9-13, directed to an image forming process. Applicants affirm their provisional election with traverse of Group I. It is noted that Claims 1-8 are cancelled herein, and replaced by Claims 14-19, which are also directed to a recording medium.

It is respectfully submitted that all of the claims could be searched by one Examiner without undue effort. It is also respectfully submitted that it is not mandatory to make a restriction requirement in every possible situation.

It is believed that if one Examiner acts on all of the claims of the present application at one time, overall examining time will be less than if two or more Examiners are involved. It is also earnestly believed that the examination of all of the claims at one time by one examiner in the present application will best ensure uniform prosecution quality. Therefore, in the interest of prosecution economy of time and quality for both the Office and Applicants, it is respectfully submitted that withdrawal of the restriction requirement in this application and examination of all pending claims on their merits are appropriate and such action is respectfully solicited.

Section 112 Rejection

Claims 1, 2, 4, 6, 7 and 8 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Without conceding the propriety of any part of this rejection, to expedite prosecution, Applicants have cancelled Claims 1-8 and replaced them with new Claims 14-19. It is submitted that Claims 14-19 comply with all aspects of Section 112, and that the Section 112 rejection is moot and should be withdrawn.

Sections 102 and 103 Rejections

Claims 1 and 2 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Inamoto (U.S. Patent No. 6,250,555).

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Ohki (U.S. Patent No. 6,398,109) in view of Inamoto and Pennisi et al. (U.S. Patent No. 5,313,365). Applicants respectfully disagree with these rejections as applied to the present claims.

Before addressing the merits of the rejections, Applicants believe it will be helpful to review some features of the present invention. The present invention, as recited in independent Claim 14, relates to an information recording medium comprising an electronic information storing circuit part, a base material and an ink receiving layer, in this order. The recording medium further comprises a barrier layer provided between the electronic information storing circuit part and the ink receiving layer so as to prevent an ink applied to the ink receiving layer from reaching the electronic information storing circuit part. The present invention, as recited in independent Claim 17, also relates to an information recording medium comprising an electronic information storing circuit part, a base material and an ink receiving layer, in this order. The ink receiving layer is thick enough to prevent an ink applied to the ink receiving layer from reaching the electronic information storing circuit part. The present invention, as recited in independent Claim 18, also relates to an information recording medium of comparable scope to that recited in Claim 14, but

without the base material. In Applicant's view, the cited references do not teach or suggest the claimed invention.

Inamoto discloses an integrated circuit (IC) card comprising a card base, and an ink receiving layer and an IC module provided on the card base. The IC module is bonded to the card base using an adhesive. (See col. 7, lines 6-8.) Applicants submit, however, that Inamoto does not disclose the structure of the claimed information recording medium, that is, an information recording medium comprising an electronic information storing circuit part, an optional base material and an ink receiving layer, in this order, further comprising a barrier layer, wherein the barrier layer is provided between the electronic information storing circuit part and the ink receiving layer so as to prevent an ink applied to the ink receiving layer from reaching the electronic information storing circuit part.

The Examiner takes the position that the resin sealant described in Inamoto is equivalent to the barrier layer of the present invention. However, as described in col. 6, line 63 to col. 7, line 6, the resin sealant is a part of the IC module, and Applicants submit that hence, it is not equivalent to the barrier layer of the present invention.

Accordingly, the information recording medium as presently claimed is not anticipated by Inamoto, and the Section 102 rejection should be withdrawn.

Ohki discloses an article carrying method using a non-contact type IC card. The Examiner takes the position that it would have been obvious for one skilled in the art to modify the IC card of Ohki (which does not teach an ink receiving layer or a barrier layer) in view of Inamoto (which teaches an IC card comprising an IC module and an ink receiving layer) as well as Pennisi et al. (which teaches an organosilicon resin as a resin to be used for sealing of an IC module). Applicants submit, however, that none of these three cited references teaches or suggests an information recording medium comprising an IC module, a base material and an ink receiving layer laminated in this order. It is further submitted that there is no motivation to combine these references in a way that would result in the claimed order of the recited components. Nor do any of the three references deal with the technical problem that may occur in such an information recording medium: that ink applied to an ink receiving layer adversely influences the IC module. In addition, none of them teaches or suggests that providing a barrier layer between the IC module and the ink receiving layer can solve that technical problem.

Accordingly, the information recording medium as presently claimed is not obvious over the cited references, either singly or in combination, and the Section 103 rejection should be withdrawn.

Conclusion

Applicants submit that the present invention is patentably defined by independent Claims 14, 17 and 18. The dependent claims are allowable for the reasons given with respect to their respective independent claims, as well as for the patentable features recited therein. Individual consideration of the dependent claims is respectfully solicited.

Applicants submit that this application is in condition for allowance. Withdrawal of the above-noted rejections, rejoinder of the withdrawn claims and issuance of a Notice of Allowance are respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
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